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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,715	10/23/2006	Wilfried Weiss	DNAG-324	8807
24972	7590	12/02/2008		
FULBRIGHT & JAWORSKI, LLP			EXAMINER	
666 FIFTH AVE			NWAONICHA, CHUKWUMA O	
NEW YORK, NY 10103-3198				
		ART UNIT	PAPER NUMBER	
		1621		
		MAIL DATE	DELIVERY MODE	
		12/02/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,715

Applicant(s)

WEISS ET AL.

Examiner

CHUKWUMA O. NWAONICHA

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date 08/17/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Current Status

1. Claims 10-19 are pending.
2. **The previous Office Action dated 05/23/2008 has been vacated in favor of this Office Action.**

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., {WO 2002020151 same as US 6,841,095} in view of Screttas et al. {US

3,780,045}, Beumel et al. {US 3,446,860} or Morrison {WO 9219622}.

Applicants claim a process comprising producing at least one of an alkyl or aryl lithium compound by reacting lithium metal with at least one alkyl or an aryl halide in at least one solvent, wherein the concentrations of the alkyl halide or the aryl halide and the alkyl or aryl lithium compound are determined by inline measurement in the reactor by IR spectroscopy; wherein all the variables are as defined in the claims.

Determination of the scope and content of the prior art (M.P.E.P. §2141.01)

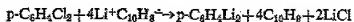
Buckley et al. teach a chemical plant for performing a chemical reaction between particles of a material such as lithium metal, and a reagent such as Bu chloride in solution in hexane, in which one reaction product is a solid material, includes a reaction vessel. Buckley et al. teach various concentrations of the reactants at a temperature up to 81°C. The reaction step is shown below.



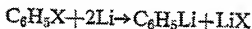
Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)

Applicants claimed process comprising producing at least one of an alkyl or aryl lithium compound by reacting lithium metal with at least one alkyl or an aryl halide in at least one solvent differs from the process taught by Buckley et al. Iwao et al. in that the prior art reference does not teach a process that produces aryl lithium compound as claimed by Applicants.

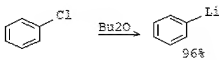
However, the secondary reference of Screttas et al. teach a process of producing an aryl lithium compound in a high yield by reacting lithium metal with aryl halide in an organic solvent at -80°C to 30°C . Screttas et al. teach various concentrations of the reactants, and the yield analyzed by NMR.



On the other hand, Beumel et al. teach a process of producing an aryl lithium compound in a high yield by reacting lithium metal with aryl halide in an organic solvent. Beumel et al. teach various concentrations of the reactants in the presence of sodium.



Morrison teaches a process of producing an aryl lithium compound in a high yield by reacting lithium metal with aryl halide in an organic solvent. Morrison teaches various concentrations of the reactants.



Finding of prima facie obviousness--rational and motivation (M.P.E.P., §2142-2143)

The instantly claimed process of producing an alkyl or aryl lithium compound by reacting lithium metal with alkyl or aryl halide in a solvent would have been obvious in view of the references cited because prior art references teach the process of producing

an alkyl or aryl lithium compound in a high yield by reacting lithium metal with alkyl or aryl halide in an organic solvent.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by conducting the process/employing the conditions from the teachings of prior art references to arrive at the instantly claimed process of producing an alkyl or aryl lithium compound. Said person would have been motivated to practice the teaching of the references cited because they demonstrate that alkyl or aryl lithium compounds is useful in industrial applications.

The Examiner notes that the use of IR to monitor the progress of a reaction as claimed by Applicants does not constitute a patentable distinction. It is well known in chemical synthesis that the progress of a reaction or a process is followed/monitored by IR, GC, NMR or other instrumental or wet chemistry techniques. Applicants claim to the use of IR to probe the reaction has no bearing on the process step claimed because Applicants are claiming a process and not a reaction vessel for making the product.

Moreover, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of prior US 7,175,784.

The presently claimed a process for producing at least one of an alkyl or aryl lithium compound by reacting lithium metal with at least one alkyl or an aryl halide in at least one solvent is disclosed in US 7,175,784. See claims 1-21 of US 7,175,784.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlaps substantially with the scope of claims 1-21 of US 7,175,784. The claims differ in that the process for producing at least one of an alkyl or aryl lithium compound by reacting lithium metal with at least one alkyl or an aryl halide in at least one solvent of the presently claimed invention is broader in scope than the process of the US 7,175,784. While applicants claim a process wherein IR is employ to monitor the progress of the reaction, the US 7,175,784 is silent about the use of IR to monitor the progress of the reactions. This difference is not a patentable distinction because US 7,175,784 teaches the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be *prima facie* obvious to one of ordinary skill in the

art. Additionally, it is well known in chemical synthesis that the progress of a reaction or a process is followed/monitored by IR, GC, NMR or other instrumental or wet chemistry techniques.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chukwuma O. Nwaonicha/
Examiner, Art Unit 1621

/Sikarl A. Witherspoon/
Primary Examiner, Art Unit 1621

Daniel Sullivan
Supervisory Patent Examiner,

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